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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,596	03/04/2005	Mikael Haeffner	P/1830-13	5789
2352 7590 05/08/2007 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			EXAMINER GREEN, ANTHONY J	
			ART UNIT 1755	PAPER NUMBER
			MAIL DATE 05/08/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/526,596	Applicant(s) HAEFFNER ET AL.	
	Examiner Anthony J. Green	Art Unit 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some * c) ☐ None of:
 - 1. ☐ Certified copies of the priority documents have been received.
 - 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01 May 2007 has been entered.
2. Claims 1-2 and 6 are currently pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-2 and 6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The phrase "soy powder" is not supported by the specification as originally filed.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Folger (US Patent No. 179,180A).

The reference teaches, in column 1, paragraph 4, the formation of a coating composition for preventing the fouling of ship bottoms comprising sea weed ashes, carbolic acid, and iodine in combination with coal dust or coal ashes which are used in the form of a powder. According to paragraph 5 the composition is mixed with linseed oil or any other suitable fluid in order to apply it to the surface of structures to be preserved against fouling.

The instant claims are obvious over the reference. While the reference does not specifically teach the use of kelp, it does broadly teach the use of sea weed and thus one of ordinary skill in the art would have found it obvious to utilize any type of seaweed such as kelp, absent evidence to the contrary. As for the addition of a binder, the linseed oil or other suitable fluid meets this limitation absent evidence showing otherwise. While the reference does not recite that it is a self polishing antifouling paint, it is well settled that when a claimed composition appears to be substantially the same as a composition disclosed in the prior art, the burden is properly upon the applicant to prove by way of tangible evidence that the prior art composition does not necessarily

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possess characteristics attributed to the CLAIMED composition. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Circ. 1990); In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); In re Swinehart, 439 F.2d. 2109, 169 USPQ 226 (CCPA 1971). As for claim 2 while the reference does not recite the addition of a photosynthesis inhibitor its addition is obvious based on the following reasoning. Since applicant recites in the instant specification that photosynthesis inhibitors are known to be compatible with known antifouling paints, one of ordinary skill in the art would have found it obvious to incorporate a photosynthesis inhibitor into the antifouling paint of the reference without producing any unexpected results absent evidence showing otherwise and thus arrive at the instant invention. As for claim 6 while the reference does not recite the size of the powder this limitation appears to be a matter of obvious choice or design best determinable through routine experimentation and optimization within the art and producing no unexpected results absent evidence to the contrary as applicant has not shown that the particle size of the powder is a critical limitation.

7. Claims 1-2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burnham (US Patent No. 575,800A).

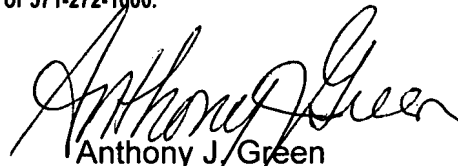
The reference teaches, in column 1, lines 24+, the formation of a coating composition for preventing the fouling of ship bottoms comprising ground kelp which is compounded with certain other ingredients which form principally a body to retain the kelp such as linseed oil (lines 40+).

The instant claims are obvious over the reference. As for the addition of a binder, the linseed oil or other suitable fluid meets this limitation absent evidence showing otherwise. While the reference does not recite that it is a self polishing antifouling paint, it is well settled that when a claimed composition appears to be substantially the same as a composition disclosed in the prior art, the burden is properly upon the applicant to prove by way of tangible evidence that the prior art composition does not necessarily possess characteristics attributed to the CLAIMED composition. In re Spada, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Circ. 1990); In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980); In re Swinehart, 439 F.2d. 2109, 169 USPQ 226 (CCPA 1971). As for claim 2 while the reference does not recite the addition of a photosynthesis inhibitor its addition is obvious based on the following reasoning. Since applicant recites in the instant specification that photosynthesis inhibitors are known to be compatible with known antifouling paints, one of ordinary skill in the art would have found it obvious to incorporate a photosynthesis inhibitor into the antifouling paint of the reference without producing any unexpected results absent evidence showing otherwise and thus arrive at the instant invention. As for claim 6 while the reference does not recite the size of the powder this limitation appears to be a matter of obvious choice or design best determinable through routine experimentation and optimization within the art and producing no unexpected results absent evidence to the contrary as applicant has not shown that the particle size of the powder is a critical limitation.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in cursive script, reading "Anthony J. Green".

Anthony J. Green
Primary Examiner
Art Unit 1755

ajg
May 3, 2007